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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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10/714,171

11/14/2003

Kazunori Yoshino

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09/08/2006

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EXAMINER

LOPEZ, FRANK D

ART UNIT

PAPER NUMBER

3745

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                   |  |
|------------------------------|-------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/714,171 | Applicant(s)<br>YOSHINO, KAZUNORI |  |
|                              | Examiner<br>F. Daniel Lopez   | Art Unit<br>3745                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on June 12, 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/25/05</u> <i>FDL</i> | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

Appellant's arguments filed June 12, 2006, have been fully considered and are persuasive. The finality of the last office action has been withdrawn.

In response to applicant's argument that the purpose of modifying Japan 2002-195,218 with Lisniansky is different than Appellant's reason for modifying Japan 2002-195,218, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellant argues that the combination of Japan 2002-195,218 and Lisniansky results in a system with a throttle valve connected in series with a variable displacement motor; whereas Appellant's claimed invention does not require a throttle valve. This is true, but the claims do not preclude a throttle valve. Therefore, the claims reads on the combination of Japan 2002-195,218 and Lisniansky, which results in a throttle valve in series with the variable displacement motor.

Appellant argues that the claims require that the variable displacement motor is between opposite sides of a hydraulic cylinder, whereas Lisniansky teaches away from this. Appellant apparently is arguing that the variable displacement motor of Lisniansky is connected between one side of a cylinder and a tank, instead of being connected between opposite sides of a cylinder. This argument is misleading. Although the motor of Japan 2002-195,218 is connected between opposite sides of a cylinder, the motor is also connected between one side of the cylinder and tank (by line 46). The motors of Lisniansky and Japan 2002-195,218 are in the same position in the circuit, being between one side of the cylinder and a tank.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

Claims 1-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Japan 2002-195,218 in view of Lisniansky. Japan 2002-195,218 discloses a power system and method of using the power system, which has a regeneration system, for a work machine comprising a hydraulic cylinder (2) fluidly connected to a hydraulic pump (3), driven by an electric motor (e.g. 42), wherein the cylinder has a movable plunger (7) defining first and second volumes (6, 5, respectively), and with a hydraulic motor (49) being fluidly connected between the first fluid volume and the second fluid volumes, in series with a throttle valve (e.g. 30) and connected to a reservoir (14, via 26); wherein the hydraulic motor powers a generator coupled to the electric motor by a power storage system; wherein the power storage system includes a fuel cell (46), an electrolysis device (4) and a hydrogen storage device (45); but does not disclose that the hydraulic motor is a variable displacement hydraulic motor.

Lisniansky teaches, for a power system and method of using the power system, which has a regeneration system, for a work machine comprising a hydraulic cylinder (1) fluidly connected to a hydraulic pump (58), wherein the cylinder has a movable plunger (21) defining first and second volumes (10, 11), and with a hydraulic motor (65) being fluidly connected to the first and second fluid volumes (by valve 2) , in series with a throttle valve (as part of valve 2), and a reservoir (62); wherein the hydraulic motor powers a a power storage system (e.g. flywheel 94); that the hydraulic motor is a variable displacement hydraulic motor, for the purpose of compensating for variations in pressure across the throttle valve (e.g. column 1 line 35-42, column 3 line 12-15 and column 3 line 64-column 2 line 2).

Since Japan 2002-195,218 and Lisniansky are both from the same field of endeavor (regenerative fluid flow), the purpose disclosed by Lisniansky would have been recognized in the pertinent art of Japan 2002-195,218. It would have been obvious at the time the invention was made to one having ordinary skill in the art to replace the constant displacement motor of Japan 2002-195,218 with a variable displacement motor, as taught by Lisniansky, for the purpose of compensating for variations in pressure across the throttle valve.

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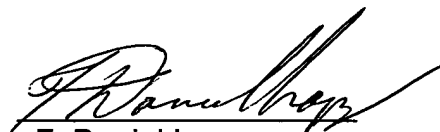
***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is 571- 272-4821. The examiner can normally be reached on Monday-Thursday from 6:15 AM -3:45 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on 571-272-4820. The fax number for this group is 571-273-8300. Any inquiry of a general nature should be directed to the Help Desk, whose telephone number is 1-800-PTO-9199.



F. Daniel Lopez  
Primary Examiner  
Art Unit 3745  
September 05, 2006